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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/537,274

05/28/2005

Alexei Borisovich Bogatyrev

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PATENT, COPYRIGHT & TRADEMARK LAW GROUP
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EXAMINER

GERRITY, STEPHEN FRANCIS

ART UNIT	PAPER NUMBER
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3721

MAIL DATE	DELIVERY MODE
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05/31/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/537,274

Applicant(s)

BOGATYREV, ALEXEI
BORISOVICH

Examiner

Stephen F. Gerrity

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: <u>20070523</u> |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Substitute Specification

1. Receipt is acknowledged of a substitute specification, filed 3 March 2007, which has been placed of record and entered in the file.

Specification

2. The abstract of the disclosure is objected to because at line 1, the phrase "The present invention relates generally to an improve device" is unnecessary as such is an implied statement; it is suggested that such be changed to --A device--. Additionally, lines 4-6, the phrase "The instant abstract ... in any way." is improper and should be deleted. Correction is required. See MPEP § 608.01(b).
3. The disclosure is objected to because at page 1 of the substitute specification, line 17, "03/00118" should be changed to --RU03/00118--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 2 and 6-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 is awkwardly written as well as vague and indefinite; perhaps the claim should be phrased as "... said element for arranging said stack of bank notes comprises

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a tubular casing which converges from an inlet to an outlet and includes a side cut-out along the full length of the tubular casing”.

Claim 6, line 3, “the longitudinal axis” is vague and indefinite; it is suggested that such be changed to --the longitudinal axis of the bank notes--.

Claim 8, lines 2 and 3, “said displacement mechanism and said pick-up unit” lacks antecedent basis.

Claim 9, lines 2 and 3, “said deformed stack of bank notes” lacks antecedent basis.

Claim 9, line 3, “in a ring taken from said container” is vague and indefinite because it has not been established that a ring is within the container. The container has been early set forth as having “packing material”.

Claim 10, line 2, the expression “the motion” is vague and indefinite because it is unclear if this is the motion of the stack or the motion of the casing.

These and any other informalities should be corrected so that the claims may particularly point out and distinctly claim the subject matter which applicant regards as the invention, as required by 35 U.S.C. § 112, second paragraph.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 3-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Hoffman et al. (**US 3,186,333**).

The Hoffman et al. reference discloses a device for packaging articles including: a body (30); a container (38) for packing material (bands 11); a means for feeding (14-17) the packing material (11); and an element (36) for arranging the articles. The recitation in the preamble regarding "banding stacks of bank notes" is not given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See In re Hira, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and Kropa v. Robie, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). The recitation regarding "stacks of bank notes" in the claim is afforded little patentable weight because it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

Regarding claim 4, the Hoffman reference discloses that the packing material is band rings stacked in a flattened condition (see figs. 2 and 10).

Regarding claim 5, the Hoffman reference discloses that the means for feeding comprises a pick-up unit (fingers 14-17) and a mechanism (77-80 - see col. 8) for displacement of the pick-up unit.

Regarding claim 6, the Hoffman reference has a guide tube (36) which is fully capable of deforming the article depending on the size of the article.

Regarding claim 7, the Hoffman reference discloses that a position sensor may be actuated by the article entering the device (col. 10, lines 55-62).

Regarding claims 8 and 9, the Hoffman reference discloses that the element (36) for arranging the articles is coupled (they are mounted on the same machine body 30) to the displacement mechanism (77-80) and the pick-up unit (14-17), and that the container (38) is also mounted to the body (30). The language "in such a way ... " (lines 3 and 4 of claim 9) are functional and capable of being performed by the Hoffman device.

8. Claims 2, 3 and 5-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Swaithe (US 3,448,557).

The Swaithe reference discloses a device for packaging articles including: a body (20); a container (40) for packing material (bags 41); a means for feeding (130 - see figs. 3 and 4); and an element (76) for arranging the articles. The recitation in the preamble regarding "banding stacks of bank notes" is not given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See In re Hirao, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and Kropa v. Robie, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). The recitation regarding "stacks of bank notes" in the claim is afforded little patentable weight because it has

been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

Regarding claim 2, the Swaites reference discloses that the element for arranging the articles comprises a tubular casing (defined by fingers 76) which converges from an inlet to an outlet, and has a side cut out along its full length (the "side" may be read as either the top side or the bottom side in Swaites).

Regarding claim 5, the Swaites reference discloses that the means for feeding comprises a pick-up unit (131, 132, 133) and a mechanism (138, 140 - see col. 5, lines 56-71) for displacement of the pick-up unit.

Regarding claim 6, the Swaites reference discloses that the element for arranging the articles deforms the articles along the longitudinal axis (see figs. 8-11).

Regarding claim 7, the Swaites reference discloses a number of position sensors (116, 117, 118, 120 and 121) for defining the position of the article.

Regarding claims 8 and 9, the Swaites reference discloses that the element (76) for arranging the articles is coupled (they are mounted on the same machine body 20) to the displacement mechanism and the pick-up unit, and that the container (40) is also mounted to the body (20). The language "in such a way ... " (lines 3 and 4 of claim 9) are functional and capable of being performed by the Swaites device.

Regarding claims 2, 10 and 11, the Swaites reference discloses that the tubular casing (defined by fingers 76) moves and thus deforms the article along the longitudinal

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axis of the article; additionally, the language of claim 11 is functional and capable of being performed by the Swaites device.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references listed on the attached form (PTO-892) are cited to show various devices for packaging and banding articles. All are cited as being of interest and to show the state of the prior art.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen F. Gerrity whose telephone number is 571-272-4460. The examiner can normally be reached on Monday - Friday from 6:30 - 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Stephen F. Gerrity/
Stephen F. Gerrity
Primary Examiner
Art Unit 3721

23 May 2007